IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Applicant:	Stephen J. Brown		
Application No.:	09/810,334	Examiner:	Koppikar, V.
Filed:	March 14, 2001	Art Group:	3686

For: INTERACTIVE PATIENT COMMUNICATION DEVELOPMENT SYSTEM FOR REPORTING ON PATIENT HEALTHCARE MANAGEMENT

REPLY BRIEF

Mail Stop - Appeal Brief Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant submits the following Reply Brief pursuant to 37 C.F.R. §41.41 for consideration by the Board of Patent Appeals and Interferences.

STATUS OF CLAIMS

Claims 1-7, 9-16 and 18-22 are pending and remain rejected. Claims 8 and 17 have been canceled. The Appellant hereby maintains the appeal the rejection of claims 1-7, 9-16 and 18-22.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The first ground of rejection is whether claims 1-7, 8, 10-16 and 18 are patentable under 35 U.S.C. §101.

The second ground of rejection is whether claims 1-7, 9-16 and 18-22 are patentable under 35 U.S.C. §102(e) over Papageorge, U.S. Patent No. 6,584,445.

ARGUMENTS

A. 35 U.S.C. §101

1. Claims 1-7 are compliant with 35 U.S.C. §101

The Examiner asserts that claim 1 is directed to a server and "the Office takes the position that a server **can comprise** software and software, per se, is not a statutory category of patentable subject matter." (Emphasis added). The Examiner does not present any evidence or make any arguments that the claimed server as a whole is non-statutory subject matter, only that a portion of the claimed server could possibly be outside a statutory category. In contrast, 35 U.S.C. §101 does not preclude patentability where at the claimed machine has a software component. As stated in M.P.E.P. §2106.01:

> Computer programs are often recited as part of a claim. USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, **the claim remains statutory irrespective of the fact that a computer program is included in the claim.** ... Only when the claimed invention taken as a whole is directed to a mere program listing, i.e., to only its description or expression, is it descriptive material per se and hence nonstatutory.." (Emphasis added).

The presence of a software component in an otherwise proper machine claim does not render the machine claim nonstatutory. Therefore, the Examiner has not established that claim 1 as a whole is directed to nonstatutory subject matter.

Furthermore, claim 1 provides that the claimed server comprises a database in a **storage medium**. One of ordinary skill in the art understands a storage medium to be a hardware device. Therefore, the claimed server as a whole is directed to a machine having a hardware component. As such, claim 1 is fully compliant with 35 U.S.C. §101 and the rejection should be reversed.

Docket Number: 01-0310 / 7553.00019
Application No.: 09/810,334   4

2. Regarding Claim 8

Claim 8 was previously canceled. Therefore, the rejection of claim 8 under 35 U.S.C. §101 is moot.

3. Claims 10-16 and 18 are compliant with 35 U.S.C. §101

The Examiner asserts that claim 10 does not recite a device which is used for carrying out the method. In contrast, claim 10 provides (C) transferring said questionnaire from a **server** to an **apparatus**, the apparatus being (i) associated with the individual and (ii) remotely located from the server. The method is carried out by a server and an apparatus, which are devices. The server and the apparatus are remotely located from each other. Therefore, both the server and the apparatus occupy space and thus are physical objects. Claims 10 further provides (D) accessing a database in **a storage medium**. The method is also carried out by a storage medium, which is a device. Therefore, the assertion by the Examiner that the claimed method does not recite a device which is used for carrying out the method is in error. The claimed method is carried out by at least three devices: the server, the apparatus and the storage medium. As such, the claimed method is tied to a statutory class of invention and the rejection should be reversed.

B.   35 U.S.C. §102

1.   Claims 1 and 6 are patentable over Papageorge

Regarding Examiner's Answer Response (1), claim 1 provides a server comprising (i) a questionnaire generator for generating a questionnaire, (ii) a database in a storage medium containing modeling information and (ii) a profile generator. The Examiner appears to agree with

Appellant's arguments in the Appeal Brief and thus no longer cites to (i) column 8 line 4 to column 9 line 33 and (ii) column 11 lines 15-30 of Papageorge in the rejection. Instead, the Examiner now cites to (i) column 6 line 66 to column 7 line 25 of Papageorge as allegedly describing elements similar to the claimed questionnaire generator, the claimed database in a storage medium and the claimed profile generator and (ii) column 1 lines 10-25 in describing the entire Computerized Health Evaluation System (CHES) as being allegedly similar to the claimed profile generator. While the newly cited text of Papageorge mentions patient and physician questionnaire forms, the cited text does not disclose any elements that one of ordinary skill in the art could consider similar to the claimed questionnaire generator, the claimed questionnaires, the claimed modeling information and the claimed profile generator. Therefore, the claim has limitations not found in Papageorge.

In particular, the plain language of the cited text and the rest of Papageorge is silent regarding any component within the CHES system that could potentially generate the questionnaire forms. Instead, column 8 lines 58-61 of Papageorge indicate that the questionnaire forms are generated as part of the development efforts to create the CHES system, and not generated by the operations of the CHES system. The cited text and the rest of Papageorge is silent regarding the alleged questionnaire generator of the CHES system associating each of the answer options with one of a second number of values representing a level of risk. The cited text and the rest of Papageorge is silent that the questionnaire forms have one or more follow-up actions. The cited text and the rest of Papageorge is silent that the questionnaire forms associating each of the answer options with one of a second number of values representing a level of risk. As such, Papageorge does not disclose or suggest all of the limitations of the claimed questionnaire generator and the claimed questionnaires.

Concerning the claimed database containing model information, the plain language of the cited text and the rest of Papageorge is silent regarding any model information. The cited text and the rest of Papageorge is silent regarding model information relating to an aspect of care. The cited text and the rest of Papageorge is silent regarding model information relating to an expression of risk. The cited text and the rest of Papageorge is silent regarding model information relating to a level of risk. Therefore, Papageorge does not disclose or suggest all of the limitations associated with the claimed database containing model information.

Concerning the claimed profile generator, the plain language of the cited text and the rest of Papageorge is silent regarding a profile generator for generating a profile for the individual based on one or more of the aspects of care, responses to the questions, the expression of risk and the level of risk associated with the individual. Therefore, Papageorge does not disclose or suggest all of the limitations of the claimed profile generator. Furthermore, if the entire CHES system is similar to the claimed profile generator, as alleged by the Examiner, then Papageorge is silent regarding a server that contains the entire CHES system as one of several components. Alternatively, if the cited text of Papageorge describes the claimed questionnaire generator and the claimed database, as alleged by the Examiner, then the entire CHES system, which is partially descried in the cited text, cannot simultaneously be similar to the claimed profile generator. The rejection contains conflicting arguments for how to apply Papageorge. As such, *prima facie* anticipation has not been established.

Regarding Examiner's Answer Response (2), claim 1 further provides that the questionnaire generator (ii) associates each of the answer options with one of a second number of values representing a level of risk, the second number of values being greater than the first number

of answer options. The Examiner appears to agree with Appellant's arguments in the Appeal Brief and thus no longer cites to (i) column 8 line 4 to column 9 line 33 and (ii) column 11 lines 15-30 of Papageorge in the rejection. Instead, the Examiner now cites to column 9 lines 55-65 of Papageorge in the rejection. While the newly cited text of Papageorge does mention a risk tolerance scale of 0 to 9 and indirectly mentions the patient and the physician questionnaire forms, cited text does not disclose any element of the CHES system that one of ordinary skill in the art could consider similar to the claimed questionnaire generator. Therefore, Papageorge does not disclose or suggest all of the limitations of the claimed questionnaire generator.

In particular, the plain language of the cited text and the rest of Papageorge is silent regarding an alleged questionnaire generator in the CHES system associating each of the answer options from the questionnaire forms with one of a second number of values representing a level of risk. The cited text and the rest of Papageorge is silent that second number of values are greater than the first number of answer options in the questionnaire form. Therefore, Papageorge does not disclose or suggest all of the claimed limitations as arranged in the claim.

Still regarding Examiner's Answer Response (2), claim 1 further provides that the database contains model information relating to (i) an aspect of care, (ii) the expression of risk and (iii) the level of risk. The Examiner appears to agree with Appellant's arguments in the Appeal Brief and thus no longer cites to column 8 line 4 to column 9 line 33 of Papageorge in the rejection. Instead, the Examiner now cites to column 9 lines 55-65 of Papageorge in the rejection. However, the cited text and the rest of Papageorge is silent regarding information having all of the limitations of the claimed model information. Therefore, Papageorge does not disclose or suggest all of the limitations associated with the claimed database containing model information.

In particular, the plain language of the cited text and the rest of Papageorge is silent regarding any model information. The cited text and the rest of Papageorge is silent regarding alleged model information relating to an aspect of care. The cited text and the rest of Papageorge is silent regarding alleged model information relating to an expression of risk. The cited text and the rest of Papageorge is silent regarding alleged model information relating to a level of risk. Therefore, Papageorge does not disclose or suggest all of the claimed limitations as arranged in the claim.

Regarding Examiner's Answer Response (3), claim 1 further provides that the physical condition of the individual comprises patient information from one or more medical claims received by the server from a medical claims paying organization associated with the individual. The Examiner appears to agree with Appellant's arguments in the Appeal Brief and thus no longer cites to column 8 line 4 to column 9 line 33 of Papageorge in the rejection. Instead, the Examiner now cites to column 5 lines 40-57 of Papageorge in the rejection. While the newly cited text mentions reports being sent to insurers, the cited text and the rest of Papageorge is silent regarding the CHES system receiving medical claims from those insurers. Therefore, Papageorge does not disclose or suggest all of the limitations associated with the claimed medical claims.

In particular, the plain language of the cited text and the rest of Papageorge is silent regarding the CHES system receiving medical claim from a medical claims paying organization associated with the patient. Furthermore, the cited text and the rest of Papageorge is silent that the CHES system obtains patient information from the alleged medical claims. Therefore, Papageorge does not disclose or suggest all of the claimed limitations as arranged in the claim.

In summary, the Examiner's Answer appears to abandon the cites used in the final

Office Action used against claim 1 in favor of new cites into Papageorge. However just like the abandoned cites, the new cites are silent regarding many of the claimed limitations as noted above. Furthermore, the Examiner does not provide any evidence or analysis to support the conclusions that the new cites anticipate the claimed limitations. The rejections remain based on conclusory statements not supported by any findings of fact or analysis. Therefore, the Examiner did not meet the burden under M.P.E.P. §2131 to establish that Papageorge discloses or suggests each of the claim limitations as arranged in the claims. As such, claims 1 and 6 remain fully patentable over Papageorge and the rejections should be reversed.

2.   Claims 10, 14 and 15 are patentable over Papageorge

The Examiner's Answer Responses (1), (2) and (3) appear to be a common set of remarks for both (i) claims 1 and 6 and (ii) claims 10, 14 and 15. Therefore, the remarks presented above by the Appellant for claims 1 and 6 are hereby incorporated for claims 10, 14 and 15. For the same reasons given above for claim 1, claims 10, 14 and 15 remain fully patentable over Papageorge and the rejections should be reversed.

3.   Claims 19 and 20 are patentable over Papageorge

Regarding Examiner's Answer Response (4), claim 19 provides a storage medium recording a computer program that is readable and executable by the server, the computer program comprising (A) displaying a plurality of icons of a plurality of questions, a plurality of answers, a plurality of follow-up actions and a plurality of follow-up answers. The Examiner appears to agree with Appellant's arguments in the Appeal Brief and thus no longer cites to (i) column 8 line 4 to

Docket Number: 01-0310 / 7553.00019
Application No.: 09/810,334   10

column 9 line 33 and (ii) the Abstract of Papageorge in the rejection. Instead, the Examiner now cites to FIG. 3 and column 6 lines 55-65 of Papageorge in the rejection. While the newly cited figure and text mention data acquisition via computers, telephones and paper, the cited text, figure and the rest of Papageorge are silent regarding the CHES system displaying question icons, answer icons, follow-up action icons and follow-up answer icons. Therefore, Papageorge does not disclose or suggest all of the limitations of the claimed storage medium recording a computer program.

In particular, claim 19 addresses how to the questionnaires are assembled using the computer program executed by the server. In contrast, the cited text of Papageorge explains different mechanisms for acquiring data once the questionnaire forms have already been created and distributed. The cited text, figure and the rest of Papageorge are silent regarding displaying question icons, answer icons, follow-up action icons and follow-up answer icons as part of assembling the questionnaire forms. Furthermore, column 8 lines 58-61 of Papageorge indicates that the questionnaire forms are generated as part of the development efforts to create the CHES system, and not generated using the CHES system itself. Therefore, Papageorge does not disclose or suggest all of the claimed limitations as arranged in the claims.

Regarding Examiner's Answer Response (5), claim 19 further provides (B) receiving a selection to each of a particular question of the questions, a particular answer of the answers, a particular follow-up action of the follow-up actions and a particular follow-up answer of the follow-up answers from a user. The Examiner appears to agree with Appellant's arguments in the Appeal Brief and thus no longer cites to (i) column 8 line 4 to column 9 line 33 and (ii) the Abstract of Papageorge in the rejection. Instead, the Examiner now cites to column 6 line 55 to column 7 line 25 of Papageorge in the rejection. As before, the cited text and the rest of Papageorge is silent

regarding a user of the CHES system entering particular questions, particular answers, particular follow-up actions and particular follow-up answers into a computer program as part of assembling the questionnaire forms. Therefore, Papageorge does not disclose or suggest all of the limitations of the claimed storage medium recording the computer program.

Regarding Examiner's Answer Response (6), claim 19 further provides (C) linking the particular icons. The Examiner appears to agree with Appellant's arguments in the Appeal Brief and thus no longer cites to column 8 line 4 to column 9 line 33 of Papageorge in the rejection. Instead, the Examiner now cites to column 6 line 55 to column 7 line 33 of Papageorge in the rejection. However, the cited text and the rest of Papageorge is silent regarding linking of particular icons as part of assembling the questionnaire forms. Therefore, Papageorge does not disclose or suggest all of the limitations of the claimed storage medium recording a computer program.

In summary, the Examiner's Answer appears to abandon the cites used in the final Office Action in favor of new cites into Papageorge. However just like the abandoned cites, the new cites are silent regarding many of the claimed limitations as noted above. Furthermore, the Examiner does not provide any evidence or analysis to support the conclusions that the new cites anticipate the claimed limitations. The new arguments for the rejections are merely conclusory statements not supported by any findings of fact or analysis. Therefore, the Examiner did not meet the burden under M.P.E.P. §2131 to establish that Papageorge discloses each of the claim limitations as arranged in the claims. As such, claims 19 and 20 remain fully patentable over reference and the rejections should be reversed.

4. Claims 2 and 11 are patentable over Papageorge

Regarding Examiner's Answer first Response (7), claim 2 provides that the profile of the individual is updated based on one or more follow-up responses. The Examiner appears to agree with Appellant's arguments in the Appeal Brief and thus no longer cites to column 8 lines 22-24 of Papageorge in the rejection. Instead, the Examiner now cites to column 7 lines 8-24 of Papageorge in the rejection. While the newly cited text of Papageorge mentions the patients providing answers to the questionnaire form, the cited text and the rest of Papageorge is silent that the questionnaire forms have follow-up actions. Hence, the questionnaire forms of Papageorge do not have any mechanism to receive responses from the patient to the non-existing follow-up actions. Therefore, Papageorge does not disclose or suggest all of the claimed limitations as arranged in the claim. As such, claims 2 and 11 remain fully patentable over the cited reference and the rejections should be reversed.

5. Claims 3, 12 and 21 are patentable over Papageorge

Regarding Examiner's Answer first Response (8), claim 3 provides that (i) the profile further comprises a language of the individual and a current health condition of the individual and (ii) the questionnaire generator also tailors the questionnaire in dependence upon the language and the current health condition of the individual. The Examiner appears to agree with Appellant's arguments in the Appeal Brief and thus no longer cites to column 7 line 65 to column 8 line 4 of Papageorge in the rejection. Instead, the Examiner now cites to column 6 lines 55-65 of Papageorge in the rejection. However just like the abandoned cites, the newly cited text of Papageorge is silent regarding a language of an individual. Therefore, Papageorge does not disclose or suggest all of the

claimed limitations as arranged in the claims. As such, claims 3, 12 and 21 remain fully patentable over the cited reference and the rejections should be reversed.

6. Claim 4 is patentable over Papageorge

Regarding Examiner's Answer second Response (7), claim 4 provides (from claim 1) (i) a profile for the individual, (from claim 4) (ii) a motivational profile and (from claim 4) (iii) a comprehensive capacity profile. The Examiner appears to agree with Appellant's arguments in the Appeal Brief and thus no longer cites to column 8 line 4 to column 9 line 33 of Papageorge in the rejection. Instead, the Examiner now cites to column 6 lines 55-65 of Papageorge in the rejection. However, the newly cited text and the rest of Papageorge is silent regarding three types of profiles. Therefore, Papageorge does not disclose or suggest all of the claimed limitations as arranged in the claims. As such, claim 4 remains fully patentable over the cited reference and the rejection should be reversed.

7. Claims 5 and 13 are patentable over Papageorge

Regarding Examiner's Answer second Response (8), claim 5 provides that the health related information (sent from the server to the individual) comprises a request for additional responses. The Examiner appears to agree with Appellant's arguments in the Appeal Brief and thus no longer cites to column 7 line 65 to column 8 line 4 of Papageorge in the rejection. Instead, the Examiner now cites to column 4 line 55 to column 7 line 25 of Papageorge in the rejection. However just like the abandoned cite, the newly cited text of Papageorge is silent regarding the CHES system sending health related information to the patients in which the health related

information comprises a request for additional responses. Therefore, Papageorge does not disclose or suggest all of the claimed limitations as arranged in the claim. As such, claims 5 and 13 remain fully patentable over the cited reference and the rejections should be reversed.

8.   Claims 7 and 16 are patentable over Papageorge

Regarding Examiner's Answer Response (9), claim 7 provides that one or more measurements received by the server from a monitoring device connected to the apparatus. The Examiner has previously suggested that the claimed apparatus is anticipated by an Internet terminal connected to the CHES system.[1] The Examiner appears to agree with Appellant's arguments in the Appeal Brief and thus no longer cites to column 8 line 4 to column 9 line 33 of Papageorge in the rejection. Instead, the Examiner now cites to column 5 lines 29-40 of Papageorge in the rejection. The newly cited text indicates that patient data is entered into the CHES system by the physician. A physician is a human being, not a monitoring device connected to an Internet terminal. Therefore, Papageorge does not disclose or suggest all of the claimed limitations as arranged in the claim. As such, claims 7 and 16 remain fully patentable over the cited reference and the rejections should be reversed.

9.   Claims 9 and 18 are patentable over Papageorge

Regarding Examiner's Answer Response (10), claim 9 provides that medical information from electronic medical records are received by the server from a services organization associated with the individual. The Examiner appears to agree with Appellant's arguments in the

---

[1] Final Office Action, page 3.
Docket Number: 01-0310 / 7553.00019
Application No.: 09/810,334   15

Appeal Brief and thus no longer cites to column 8 line 4 to column 9 line 33 of Papageorge in the rejection. Instead, the Examiner now cites to column 5 lines 40-57 of Papageorge in the rejection. However just like the abandoned cite, the newly cited text of Papageorge is silent regarding the CHES system receiving medical records from a service organization associated with the patient. Therefore, Papageorge does not disclose or suggest all of the claimed limitations as arranged in the claim. As such, claims 9 and 18 remain fully patentable over the cited reference and the rejections should be reversed.

10. Claim 22 is patentable over Papageorge

Regarding Examiner's Answer Response (11), claim 22 provides simulating the questionnaire prior to the transmission of the questionnaire to the one or more patient devices. The Examiner has narrowed the cite into Papageorge in the rejection from column 8 line 4 to column 9 line 33, as used in the final Office Action, to just column 8 lines 47-49 in the Examiner's Answer. However, for the same reasons as given in the Appeal Brief, the cited text and the rest of Papageorge is silent regarding simulations of the questionnaire forms. The cited text of Papageorge reads:

> h. Conduct cost-effectiveness analysis to compare costs of each treatment to survival, continued morbidity, and mortality.

Nothing in the cited text mentions simulations of the questionnaire forms. Therefore, Papageorge does not disclose or suggest all of the claimed limitations as arranged in the claim. As such, claim 22 remains fully patentable over the cited reference and the rejections should be reversed.
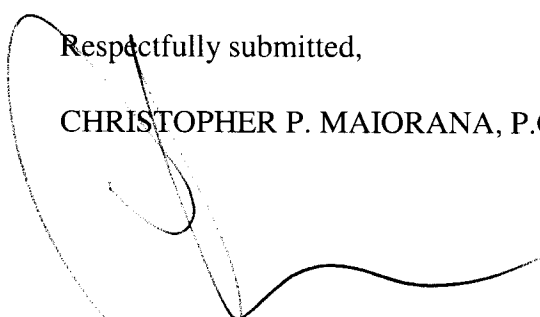
C.   __CONCLUSION__

The final Office Action was deficient in at least the following areas. Papageorge does not suggest a server generating a questionnaire. Papageorge does not suggest one or more follow-up actions in the questionnaire. Papageorge does not suggest associating each of the answer options with one of a second number of values representing a level of risk. Papageorge does not suggest a database in a storage medium, the database containing model information. Papageorge does not suggest patient information from one or more medical claims. Papageorge does not suggest displaying a plurality of icons of a plurality of questions, a plurality of answers, a plurality of follow-up actions and a plurality of follow-up answers. Papageorge does not suggest receiving a selection to each of a particular question of the questions, a particular answer of the answers, a particular follow-up action of the follow-up actions and a particular follow-up answer of the follow-up answers from a user. Papageorge does not suggest linking the particular icons. Papageorge does not suggest converting the linked icons into a questionnaire. The new cites into Papageorge provided in the Examiner's Answer do not cure any of these deficiencies. Hence, the Examiner has clearly erred with respect to the patentability of the claimed invention. As such, it is respectfully requested that

the Board overturn the Examiner's rejection of all pending claims, and hold that the claims are not

rendered anticipated by the cited reference.

Respectfully submitted,

CHRISTOPHER P. MAIORANA, P.C.

Christopher P. Maiorana
Registration No. 42,829

Dated: June 11, 2009

c/o Sandeep Jaggi
Health Hero Network

G:\HealthHero7553\00019\REPLY-brf.wpd